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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/730,800

12/09/2003

Debjit Das Sarma

5500-97400

2698

53806

7590

03/20/2008

MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL (AMD)

P.O. BOX 398

AUSTIN, TX 78767-0398

EXAMINER

NGO, CHUONG D

ART UNIT

PAPER NUMBER

2193

MAIL DATE

DELIVERY MODE

03/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/730,800 | Applicant(s) SARMA, DEBJIT DAS | |
| | Examiner Chuong D. Ngo | Art Unit 2193 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 26-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Newly submitted claims 26-28 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Original claim 1-22, drawn to a circuit and method of floating point multiplication, class 708, subclass 503.

Newly submitted Claims 26-28 drawn to a variable precision microprocessor, classified in class 708, subclass 513.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of the newly submitted claims and the original claims are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (newly submitted Claims) does not require the particular multiplication of the subcombination (Original claim) as claimed for patentability because claims to both the combination and subcombination are presented and assumed to be patentable. The omission of the specific details of the multiplier circuit in the combination is an evidence that the combination (II) does not rely on the details of the specific subcombination (I), for patentability. In addition, the subcombination (I) clearly has a separate utility as performing multiplication. Therefore, the inventions I and II are clearly distinct. In addition, there would be a serious burden on the examiner if restriction is not

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required because the inventions have acquired a separate status in the art in view of their different classification, and the search for the microprocessor as recited in claim 26 is not required for the multiplication of the original claims. Therefore, a restriction as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 26-28 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-22 are directed under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-22 are directed to apparatus and method for merely performing manipulations and calculations of data values. In order for a such a claimed invention that merely involves manipulation and calculation of data values to be statutory, the claimed invention must accomplish a practical application, and is not directed to a preemption of a calculation and/or manipulation data . That is the claimed invention must transform an article or physical object to a different state or thing, or produce a useful, concrete and tangible result and not cover every substantial practical application . See State Street 47 USPQ2d, Benson 175 USPQ , and “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter

Eligibility”, OG Notices: 22 November 2005. It is clear from claims 1-22 that the claims merely involve calculations and manipulations of data. The claimed invention does not transform an article or physical object to a different state or thing. The inputs are numerical values and the output is also a numerical value. The result produced by the inventions do not have a real world value but merely numerical values without a practical application recited in the claims to make the result useful, concrete and tangible. Therefore, claims 1-22 are directed to non-statutory subject matter as the claimed invention fails to accomplish a practical application. Further, since the claims appear to cover every substantial practical application, they are also directed to a preemption of the claimed manipulation and calculation of data.

5. Applicant's arguments filed on 12/23/2007 regarding the rejection under 35 USC 101 have been fully considered but they are not persuasive.

Regarding the rejection under 35 USC 101, it is respectfully submitted that since the claimed invention merely involves in calculations and manipulations of data in performing computations, It is required the claimed invention to transform an article or physical object to a different state or thing, or produce a useful, concrete and tangible result, and not cover every substantial practical application in order to be statutory subject matter regardless whether the claimed invention is written in a method or apparatus form. In the present application, the claimed invention does not transform an article or physical object to a different state or thing. The result produced by the inventions are mere numbers without a practical application recited in the claims to give the result real world value, and thus is not useful, concrete and tangible. Therefore, the claims fail to meet the requirements. It should be noted that in State Street, the

claimed data processing system is statutory subject matter because it produces a useful, concrete and tangible result --a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades --, not because it is an apparatus. Further, since the claims appear to cover every substantial practical application, they are also directed to a preemption of the claimed manipulation and calculation of data. Therefore, it is respectfully submitted that the rejection of claims 1-22 as being directed to non-statutory subject matter is proper.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chuong D. Ngo whose telephone number is (571) 272-3731. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lewis, Jr. A. Bullock can be reached on (571) 272-3759. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chuong D Ngo/
Primary Examiner, Art Unit 2193

03/14/2008